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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,871	12/21/2001	Masanori Wakai	35.C16065	4674
5514 7590 07/17/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NGUYEN, TAN D	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/023,871

**Applicant(s)**

WAKAI ET AL.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 3/16/07 has been entered. Claims 1-66 are pending and rejected as followed.

#### ***Claim Rejections - 35 USC § 112***

1. Claims 1-5, 15-16, 17-28, 31-35, 45-46, and 61-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claims 31, 1, 15, 17, 45 and 61-66, the phrase "receiving an approval service" and "storing the approval service" are vague because "service" deals with tasks or activities or steps which can not be received or stored. It appears that the step receiving and storing deals with "information" or "data" about the approval service and wherein the information/data can be stored. Corrections are required to improve clarity.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 31-35, 36-44, 45-46, 47-58, 59, and 60 (methods (6)), 1-5, 6-14, 15-16, 17-28, 29 and 30 (respective systems (6) for the previous methods (6)), 61, 62, 63, 64, 65 and 66 (computer programs (6) for the previous methods (6)) are rejected under 35 U.S.C. 103 as being obvious over JEMELLA et al.**

As of 3/16/07, independent method claim 31 is as followed:

31. (Currently Amended) An information processing method comprising:

- (a) a receiving step for receiving an approval service which includes a decision condition set by a user of an approval service provider;
- (b) a storage step of storing the approval service received in said receiving step;
- (c) an approval request preparing step for preparing an approval request based on values entered by a user;

(d) a decision step of deciding whether or not to approve said prepared approval request, based on said stored approval service; and

(e) an output step of outputting the result of the decision of said decision step.

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

Similarly, JEMELLA et al discloses an information processing method comprising:

(a) a receiving step for receiving an approval service information which includes business rules and roles for making a consistent and intelligent decision regarding a request and set by a user of an approval service provider;

{see col. 1, lines 35-40, col. 2, lines 20-50, col. 3, lines 1-5}

(b) a storage step of storing the approval service received in said receiving step;

{see col. 3, lines 20-25, col. 9, lines 40-50}

c) an approval request preparing step for preparing an approval request based on values entered by a user;

{see col. 1, lines 20-25, col. 8, lines 40-50,

(d) a decision step of deciding whether or not to approve said prepared approval request, based on said stored approval service; and

{see col. 1, lines 40-65, col. 2, lines 55-65, col. 3, lines 10-15, col. 11, lines 56-60}

(e) an output step of outputting the result of the decision of said decision step.

{see Fig. 5, 600, claim 1}.

JEMELLA et al fairly teaches the claimed invention except for the information of step (a) including a decision condition set by a user. However, as cited on cols. 2 to col. 3, lines 15, the business rules and business roles are for making a consistent and intelligent decision that consider high value customer protocols and other business issues, therefore, it would have been obvious to consider the business rules and business parameters set in col. 3, lines 9-15, as "decision conditions" since they affect the final decision.

As for dep. claim 32 (part of 31 above), which deals with step of execution a process upon approval, this is taught in col. 2, lines 45-65.

As for dep. claims 33-34 (part of 31 above), which deals with the types of decision conditions or well known conditions parameters, these are non-essential to the scope of the invention and are fairly taught in col. 3, lines 5-15.

As for dep. claim 35 (part of 31 above), which deals with well know decision making parameters, i.e. prohibition period for approval decision, this is fairly taught in col. 3, lines 5-45.

As for claims 36-44, 45-46, which have similar limitations as in claims 31-35 above, they are rejected for the same reasons set forth above.

As for claim 47, which has similar limitation as in claim 31 above, it's rejected over the same reason set forth in claim 31 above.

As for claim 48, this is taught in col. 3, lines 5-40.

As for dep. claim 56-58 (part of 47 above), these are inherently included in the teaching of JEMELLA et al col. 2, line 56 to col. 3, line 67.

As for claims 59-60, which have similar limitations as in claims 32, 33-34 and 48 above, they are rejected for the same reasons set forth above.

**As for independent system claim 1**, which is basically the system to carry out the independent method claim 31 above, it is rejected over the system of JEMELLA et al to carry out the method claims as rejected above. Alternative, the set up of an equivalent computer system to carry out an equivalent computer-implemented method steps would have been obvious to a skilled artisan, a computer programmer.

Similarly, dependent claims 2-5 (part of 1 above), are rejected for the same reasons set forth in dependent claims 32-35 (part of 31 above) as cited above.

Similarly, system claims 6-18, 26-30, are rejected for the same reasons set forth in system claims 1-5 above because they are merely the system to carry out method claims 36-48, 56-60.

**As for independent computer program claim 61** which is the computer executable codes for carrying out the method claim 31 above, it's rejected over the computer program inherently included in the system of JEMELLA et al to carry out the rejection of method claim 31 as cited above.

Similarly, **computer program of claims 62, 63, 64, 65, and 66**, which are the computer executable codes for carrying out the method claims 36, 45, 47, 59-60 respectively above, they are rejected for the same reasons set forth in claim 61 above.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.



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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

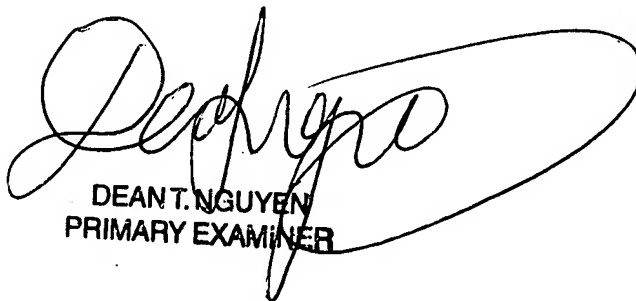
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
July 7, 2007



DEAN T. NGUYEN  
PRIMARY EXAMINER